

REMARKS

Claims 1, 4-13, 16-25, and 27 are pending in the application. Claims 1, 4-13, 16-25, and 27 stand rejected

Claims 1, 4, 5, 11-13, 16, 17, 23-25 and 27 are rejected under 35 USC 103(a) Buettgenback et al (20002/0032613), hereafter "613", in view of Walker et al. (6,754,636) (Walker).

Claims 6 and 8 are rejected under 35 USC 103(a) as unpatentable over '613 and Walker and further in view of Zarovinsky (2002/0133415) and claims 7-10 and 19-22 are unpatentable over '613 and Walker and further in view of "Re: Astropix Wholesale Optics."

The Office Action points to both P. 71 and P. 54 of '613 to show a confirmation unit confirming, through the agency service trader's place, the identification information received by said communication terminal used by the orderer and setting the identification information so as to contain numerals of specified digits of a telephone number corresponding to said communication terminal used by the orderer that is contained in the order information.

Nowhere in either of these paragraphs are these features shown in '613. The closest '613 comes is in P. 54 where it is stated that other forms of recipient identification systems include identification through credit cards, specially-issued membership cards, employer ID badge numbers, driver's license numbers, social security numbers, phone numbers, thumbprints, recipient's vehicle license plate number, wireless identification devices, student IDs, and the like.

If a recipient ID is a phone number or a wireless identification device there is no teaching of applicant's specific combination of features. For example, assuming for augment sake that a wireless device is used as a recipient ID system, nowhere does '613 describe that the wireless device is a communication terminal, the wireless device receives identification information

which is used by the confirming unit and the identification information including numerals of specified digits of a telephone number corresponding to wireless device.

Since several of these claimed features were not particularly pointed out in the Office Action, clarification as to where these features are shown in the references is requested.

Also applicant's unique combination of features are not found in the combination of references including the identification information received by said communication terminal used by the orderer and setting the identification information so as to contain numerals of specified digits of a telephone number corresponding to said communication terminal used by the orderer that is contained in the order information.

Both the 613 and Walker references describe telephone information however nowhere is the telephone number and communication terminal taught as claimed by applicant.

In reviewing the entire Walker specification nowhere is the identification information set to correspond to a telephone number of a communication terminal used by the orderer. The Walker reference does describe telephone information however this information is always described as input by the buyer and used to identify the buyer. The Walker reference does not describe the combination of the confirmation unit and the recited use of the telephone number in the received ID information. The Office Action only points to Fig. 22 which describes a voucher system and which teaches nothing of applicant's claimed features.

Old and Well-known in the Art

In the Office Action of September 9, 2004 the Examiner applied "old and well known in the art" to claims 2 and 14. Claims 2 and 14 were latter cancelled. While a somewhat similar feature was added to claims 1 and 13, these claims are different and have a different combination of features as was rejected in the Office Action of September 9, 2004.

This rejection is traversed for at least the following reasons:

Applicant claims a unique combination of features. Even if the specific one way function is well known, applicant is claiming identification information unique to every orderer and to every target article from a one-way function on the basis of the order information received from said virtual shop there is no suggestion for making such a combination of features including all the additional features recited in claims 1 and 13. In addition even if providing unique identification information to every order is well known there is no suggestion of the combination of identification with regard to the generation unit.

Thus even if all the elements were present in the cited references, it is well-established that a combination of limitations, some of which separately may be known, may be a new combination of limitations which is nonobvious under the condition of 35 U.S.C. 103.

Moreover, "an examiner may often find every element of a claimed invention in the prior art." *In re Rouffet*, 47 USPQ3d 1453, 1457 (Fed. Cir. 1998). However there must be a motivation to combine the reference.

The Office Action only recites that it is "well-known" without providing any reference to judge this assertion by or allow applicant to judge the motivation to combine. A reference is requested which allows applicant to judge this assertion.

Further the Office Action points to the MPEP, which applicant notes states "[a]ny rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is

never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421.

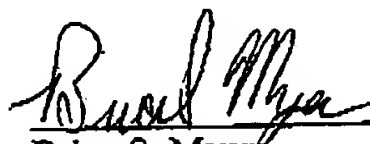
Applicant contends that the specific features of identification information unique to every orderer and to every target article from a one-way function on the basis of the order information received from said virtual shop were not addressed other than stating a portion of this was found in Walker, however no motivation was given to combine, nor is it clear whether "on the basis of the order information received from said virtual shop" is also considered old and notorious. This is not simply a "fill in the gaps" therefore a reference is requested.

It is respectfully submitted that applicant's claimed invention each of the independent claims 1, 13 and 25 is traversed for at least the foregoing reasons.

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,



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Docket No.: FUJY 19.187 (100794-00088)
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